

## **REMARKS**

Reconsideration of this application based on the following Remarks is respectfully requested.

The Office Action is in reply to the Supplementary Response Under 37 C.F.R. §1.111 filed on February 5, 2004.

### **Double Patenting**

The Examiner has rejected claims 12, 9, 13, 14, 15 and 19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent 6,415,165 B1 by the present inventor Masahiro Ishigami (filed July 9, 1999 - published July 2, 2002 - assigned to NEC) in view of Moriya, UK Patent Application GB 2,328,343 (published February 17, 1999).

The applicant respectfully calls to the Examiner's attention that the Examiner erroneously refers to claim 9 (at the top of page 3, paragraph 4), instead of to claim 12.

The applicant herein demonstrates that the conflicting patent is commonly owned with this application, as follows. The applicant calls to the Examiner's attention that U.S. Patent No. 6,415,165 B1 was issued to Ishigami, filed July 9, 1999, issued July 2, 2002, and assigned to the NEC Corporation of Tokyo, Japan. The present application of Ishigami was filed on March 22, 2000 and is assigned also to the NEC Corporation of Tokyo, Japan, as recorded on March 22, 2000 on Reel 010642 and Frame 0576.

Accordingly, the applicant herein encloses a Terminal Disclaimer to Obviate a Double Patenting Rejection Over a Prior Patent which is in conformance with 37

CFR 1.321(c). Therefore, the applicant respectfully requests that the Examiner withdraw the rejections of obvious type double patenting of claims 12, 9, 13, 14, 15 and 19.

**35 U.S.C. 112, Second Paragraph**

The Examiner has rejected claims 9-11, 13-15, 17, 19 and 20 under 35 U.S.C. §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant had amended claim 12 to recite the limitation:

a processor performing processing according to a position at which, or a manner in which, said user presses said touch panel, ~~said processing corresponding to a single click or a double click of a mouse~~ wherein pressing said touch panel once accepts said recognized information and pressing said touch panel twice selects the entry operation.

For support for the amendment, the applicant pointed to page 17, line 20, to page 18, line 5; page 18, line 23, to page 19, line 1; and to FIGS. 3, 8 and 9.

The Examiner is asserting that the desired functionality is performed by pressing a key (and not by pressing a touch panel), according to page 17, lines 20-22, and page 18, lines 10-13, and page 18, line 23, to page 19, line 1. The Examiner also refers to page 15, line 15, to page 16, line 8, as disclosing that the pressing is directed to an Accept key.

Since the Examiner is requiring further clarification and support for the amendment to claim 12, the applicant maintains that such support is provided by page 27, lines 7-9, which discloses the following:

Instead of allocating the Accept key as the operation switch of the cellular phone, the switch may also be provided on the touch panel.

Therefore, the switch on the touch panel can be pressed once or twice, as recited by claim 12.

As a result, the applicant respectfully requests that the Examiner withdraw the rejections of claims 9-11, 13-15, 17, 18 and 20 under 35 U.S.C. §112, second paragraph.

### **35 U.S.C. 103(a) Rejections**

#### **Claims 12, 9, 13, 14, 15 and 19**

The Examiner has rejected claims 12, 9, 13, 14, 15 and 19 under 35 U.S.C. 103(a) allegedly as being unpatentable over Prior et al (US 6,349,220 B1 - filed October 27, 1998 - issued Feb. 19, 2002) in view of Moriya (GB 2 328 343 A - issued Feb. 17, 1999- applicant NEC) and further in view of Shigeru (Japanese Patent Application No. 09-120960, Publication No. 10-313433, published November 24, 1998).

The Prior et al and the Moriya references were previously cited in the Final Rejection of July 16, 2003. The Shigeru reference is a new reference.

Regarding claim 12, the Examiner states on page 7 that Prior in view of Moriya do not specifically teach of wherein pressing said touch panel once accepts said recognized information and pressing said touch panel selects the entry.

The Examiner asserts that Shigeru, in paragraph 0029 and in the Solution, teaches of wherein pressing said touch panel once accepts said recognized

information and pressing said touch panel selects the entry.

In response, the applicant maintains that, in actuality, paragraph [0029] of Shigeru (according to the machine translation provided by the USPTO) discloses the following with reference to Drawing 3:

In actuation of the rotation actuation means 15, the cursor currently displayed on the drop 13 can be moved up and down by rotating jog dial 15A. Moreover, if jog dial 15A is depressed once and Switch SW is operated, the class of lower layer program of the class program with cursor will be displayed with class of the program of a certain. Then, if predetermined time amount jog dial 15A is not pushed, the display of a drop 13 will return from the class of lower layer program to the class of program of the original upper layer. Furthermore, if it continues in predetermined time and jog dial 15A is depressed twice, playback of the class of program with cursor will be decided and the program will be reproduced from a loudspeaker.

The Solution of Shigeru discloses the following:

A turn operation means 15 supplies an input signal (control signal) to a controller 9. The controller 9 supplies the control signal to a indicator 13 which displays the kind of a program based on a display signal from the controller 9. When the program kind is displayed on the indicator 13, a cursor signal is supplied to the indicator 13 from the controller 9, thus a cursor is simultaneously displayed. The cursor is vertically moved through the turning of a jog dial of the

means 15. If the jog dial is pressed down twice in a row within a prescribed time, the reproduction of the kind of a program pointed by the cursor is determined and the program is reproduced.

Furthermore, the applicant calls to the Examiner's attention that the applicant of the Shigeru application is the Sony Corporation. The applicant is enclosing a printout of the following website (Enclosure 1):

<http://sonyelectronics.sonymstyle.com/micros/ctie/tg50features/jogdial.html> ✓

In addition to the disclosure of Shigeru, the applicant maintains that the website also discloses that a jog dial is similar to a wheel dial, and therefore, pressing of the jog dial is not equivalent to pressing said touch panel once accepts said recognized information and pressing said touch panel twice selects the entry operation, as recited by claim 12. Rather, pressing a jog dial is analogous to pressing a key on a key board rather than pressing a touch panel. As a result, none of the prior art references, taken alone or in combination, disclose, teach or suggest the limitations of claim 12. Consequently, claim 12 patentably distinguishes over the prior art.

The Examiner now rejects claim 19 by asserting that it is inherent in Moriya to have such a device in that FIG. 7 discloses hand-written characters.

The applicant maintains that neither Shigeru nor Moriya overcome the deficiencies of Prior et al with respect to claim 12. In that claims 9, 13-15 and 19 depend directly or indirectly from claim 12, claims 9, 13-15 and 19 patentably distinguish over the prior art. As a result, the applicant respectfully requests the Examiner to withdraw the rejections of claims 9, 12-15 and 19 over the prior art.

**Claims 10, 11, 17 and 20**

The Examiner has rejected claims 10 and 11 under 35 U.S.C. 103(a) allegedly as being unpatentable over Prior et al in further view of Moriya and Shigeru as applied to claim 12 above, and further in view of Armstrong et al (US 5,729,219 - filed Aug. 2, 1996 - issued March 17, 1998).

The Examiner has rejected claim 17 under 35 U.S.C. 103(a) allegedly as being unpatentable over Prior et al in further view of Moriya and Shigeru as applied to claim 12 above, and further in view of Kisaichi et al (US 5,786,776 - filed March 12, 1996 - issued July 28, 1998).

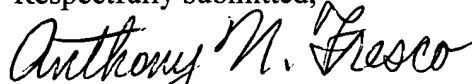
The Examiner has rejected claim 20 under 35 U.S.C. 103(a) allegedly as being unpatentable over Prior et al in view of Moriya and Shigeru, as applied to claim 19, and further in view of Capps et al (US 5,583,833 - filed June 6, 1995 - issued December 10, 1996)

The Armstrong et al, the Kisaichi et al, and the Capps et al references were cited previously. The applicant maintains that none of the secondary references overcomes the deficiencies of Prior et al with respect to claim 12. As a result, claims 10, 11, 17 and 20 patentably distinguish over the prior art. Consequently, the applicant respectfully requests the Examiner to withdraw the rejections of claim 10, 11, 17 and 20 over the prior art.

The applicant respectfully requests consideration of the foregoing Remarks in conjunction with the accompanying Terminal Disclaimer. The foregoing Remarks and accompanying Terminal Disclaimer establish the patentability of all of the claims remaining in the application, i.e., claims 9-15, 17 and 19-20. No new matter has been

added. Wherefore, early and favorable reconsideration and issuance of a Notice of Allowance are respectfully requested.

Respectfully submitted,



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Enclosure: <http://sonyelectronics.sonystyle.com/micros/clie/tg50features/jogdial.html>

dated July 21, 2004 (2 pages)

09/532.235 ENCLOSURE I

CLIE® Personal Entertainment Organizer

SONY

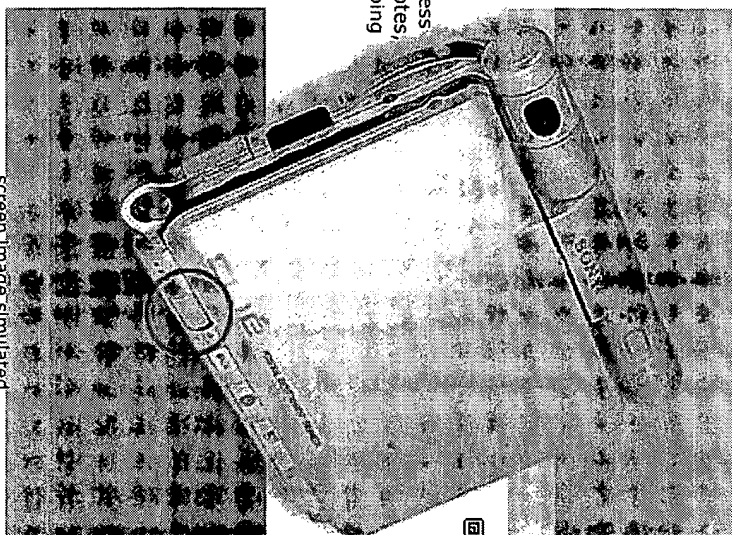
MODELS	ACCESSORIES	SOFTWARE	WIRELESS	NEWS	SUPPORT	DEVELOPERS	eBOOKS	PROMO	STORE	GAMES
<input type="checkbox"/> PEG-UX50 <input type="checkbox"/> PEG-TH5 <input type="checkbox"/> PEG-TJ37 <input type="checkbox"/> PEG-TJ27 <input checked="" type="checkbox"/> CLASSICS <input checked="" type="checkbox"/> COMPARISON										

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JOG DIAL™

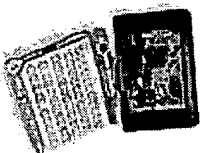


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DEMO

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This demo requires the Macromedia  
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player, click [here](#).

09/532,235 ENCLOSURE 1

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